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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/818,125	03/26/2001	Masahiro Minowa	81747.0191	8629
26021	7590	08/03/2005	EXAMINER	
HOGAN & HARTSON L.L.P. 500 S. GRAND AVENUE SUITE 1900 LOS ANGELES, CA 90071-2611			RETTA, YEHDEGA	
			ART UNIT	PAPER NUMBER
			3622	

DATE MAILED: 08/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/818,125	Applicant(s) MINOWA, MASAHIRO	
	Examiner Yehdega Retta	Art Unit 3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 June 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Handwritten signature/initials.

DETAILED ACTION***Response to Amendment***

Applicant submitted a copy of English translated Japanese document perfecting the filing date of the priority document, therefore the finality of the last office action is withdrawn.

Claim Objections

Claim 22 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

The test for a proper dependent claim is whether the dependent claim includes every limitation of the parent claim. The test is not whether the claims differ in scope. A proper dependent claim shall not conceivably be infringed by anything, which would not also infringe the basic claim. If independent claim recites a method of making a specified product, a claim to the product set forth in the independent claim would not be a proper dependent claim since it is conceivable that the product claim can be infringed without infringing the base method claim if the product can be made by a method other than that recited in the base method claim. Therefore, claim 22 is improper dependent claims.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

Art Unit: 3622

the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-15 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marshall et al. (US 6,650,429), in view of Sleeper (US 6,401,074) and further in view of Hunter et al. (US 6,650,429).

Regarding claims 1, 3-6, 12-15, Marshall teaches as server (control center) providing means for receiving and storing input information containing advertising placement information (see col. 7 lines 44-53, col. 8 lines 1-29); (control center providing support to the database manager and transmission sequence compiler) means for distributing specific data in the input information to a individual entities, stores or retail system, such as kiosk, receiving the specific data through printer appliances or receiver-printer dispensers, in a specified area specified by the PC (see col. 7 lines 54-60, col. 8 lines 10-18, col. 6 lines 34-64); and a server providing control means for controlling printing the advertising placement information on the printer or receiver-printer dispenser, system receiving the distribution, central computer connected to the server (see col. 3 line 59 to col. 4 line 11, col. 11 line 55 to col. 14 line 5). Sleeper teaches in addition to displaying the message, printing the advertisers message on a receipt of POS system, including POS terminal, and charging advertisers fee for displaying and printing the message; a central computer integrally controlling the POS system (see col. 3 lines 11-67 col. 4 lines 28-39, col. 9 line 60 to col. 10 line 5). It would have been obvious to one of ordinary skill in the art at the time of the invention to also print the message of Marshall, on the POS system, as in Sleeper, since it is known for retails to provide check-out coupons to customers so they can redeem the coupon. Marshall teaches providing

Art Unit: 3622

access to the subscribers directory (see col. 7 lines 10-19), electronically receiving entered to the database (see col. 13 lines 24-29), or add the promotions directly (see col. 17 lines 54-59) however does not explicitly teach providing an application page containing advertisement placement application form. Hunter teaches accessing a central station via the Internet through interface web server sending advertisement content and for scheduling and purchasing advertisement time for displaying advertisement in specific locations (see col. 3 lines 1-21). It would have been obvious to one of ordinary skill in the art at the time of the invention to use a web interface, as in Hunter, in Marshall's message receiving and broadcasting system, since web interface provides since web pages can be accessed from user computer and provide links to other pages.

Regarding claim 2, Marshall teaches posting, dispatching messages and tracking sender volumetric for billing (see col. 7 lines 49-64) however does not teach means for calculating an advertising placement fee, means for storing and sending the calculated fee information to the client PC, means for confirming fee payment. Hunter teaches billing and report generation module providing reports showing calculating advertisement placement fee storing and sending the calculated fee information and payment to user. It would have been obvious to one of ordinary skill in the art at the time of the invention for one to know that the retail stores of Marshall and Sleeper would charge fee for displaying and printing the advertisement, in order to generate revenue by providing promotional display, as taught in Sleeper, and to inform the advertisers by providing billing system for the service provided, as taught in Hunter.

Regarding claim 3, Marshall teaches plurality of POS system installed in plurality of branches or stores of chain store (see 13 lines 18-29, col. 17 line 53 to col. 18 line 19).

Art Unit: 3622

Regarding claims 4-6, Marshall teaches enabling selection of one place name form a plurality of names of places or area, chain stores where advertisement can be placed, by selecting serial number of the printers (see col. 6 lines 37-64, col. 7 lines 1-64).

Regarding claims 7, 8, 10, 11, Marshall teaches enabling specification of one or more conditions restricting advertising placement, specifying advertising period, specific time period, target (see col. 8 line 10-25, col. 13 lines 18-53).

Regarding claim 9, Marshall teaches tracking of volume for billing sender (advertiser), however does not teach specification of number of pages printed. Official notice is taken that is old and well know in advertisement to specify the number of ad prints or volume and to be charged based on the number of ads printed or displayed. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention provide a page for specifying the number of prints for those who prefer to pay fee based on the number of printed coupons, rather than based on time period, in order to make sure that advertiser is paying only for coupons that are provided to customers.

Claim 23 is rejected as stated above in claim 1.

Claims 16-22, are rejected under 35 U.S.C. 103(a) as being unpatentable over Sleeper (US 6,401,074) and further in view of Hunter et al. (US 6,650,429).

Regarding claims 16, 18, 21 and 22 Sleeper teaches receiving and storing advertisement placement information, charging fee for the placement of the advertisement, registering in the POS system advertising information and outputting advertisement by means of a printer device, charging the advertisers for placement of the advertisement; sending specific information to the POS system; distributing by central

Art Unit: 3622

computer connected to POS, via the Internet (see col. 3 lines 1-67, col. 6 lines 50-67, col. 8 lines 47 to col. 8 line 67, col. 9 line 60 to col. 10 line 3). Sleeper does not teach how the advertisers submit the advertisement placement information that is displayed and printed by the retailer stores (POS) and calculate an advertisement fee based on the input information, it is taught in Hunter. Hunter teaches providing application page containing an advertisement application form for receiving and storing information containing advertisement placement information (see col. 2 line 66 to col. 3 line 30), calculating fee based on the selection; sending specific information to the be displayed (see col. 3 line 62 to col. 4 line 46). It would have been to one of ordinary skill in the art to provide application page for receiving and storing information containing advertisement placement information and calculated fee based on the input information. One would be motivated to provide advertisers a direct access for purchasing promotional displays and for directly sending their ads electronically, to be displayed at the locations and time selected by the advertiser as taught by Hunter (see col. 1 lines 7-18 and col. 2 lines 1-25), and to calculate fee that would provide revenue.

Regarding claim 17, Hunter teaches payment using debit payment or other suitable payment code (see col. 4 lines 44-47). Official notice is taken that is old and well known in credit card processing, to confirm credit card validity by a credit card company or banks. It would be obvious to one of ordinary skill in the art at the time of the invention for someone to know that Hunter's payment system would confirm the validity of the credit card used for payment by contacting the credit card issuer to avoid fraud.

Art Unit: 3622

Claim 19, are rejected under 35 U.S.C. 103(a) as being unpatentable over Sleeper (US 6,401,074) in view of Hunter et al. (US 6,650,429) and further in view of Marshall et al. (US 6,650,429).

Regarding claim 19, Sleeper does not teach confirming a POS system specified by the input information and sending the information to the confirmed POS system, it is taught in Marshall (see col. 7 lines 49-64, col. 8 lines 10-29). Marshall teaches specifying which stores receive the message and transmitting the message to the stores selected by conforming the serial number of the printer, therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to implement Marshall's selected distribution system in Sleeper's displaying and printing of advertisers messages to provide advertisers an option for selectively displaying or printing their advertisement at specific locations or time, as taught in Marshall.

Response to Arguments

Applicant's arguments with respect to claims 1-23 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion


The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yehdega Retta whose telephone number is (571) 272-6723. The examiner can normally be reached on 8-4:30.

Art Unit: 3622

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


RETTA YEHDEGA
PRIMARY EXAMINER

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